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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/893,223   | 06/27/2001  | Shane M. Kelton      | 163.1062USD1        | 5643             |
| 23552  | 7590        | 06/02/2003           |                     |                  |
| MERCHANT & GOULD PC<br>P.O. BOX 2903<br>MINNEAPOLIS, MN 55402-0903 |             |                      | EXAMINER            |                  |
|  |             |                      | DICUS, TAMRA        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1774                | 7                |
| DATE MAILED: 06/02/2003  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |
|------------------------------|-----------------|---------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |
|                              | 09/893,223      | KELTON ET AL. |
|                              | Examiner        | Art Unit      |
|                              | Tamra L. Dicus  | 1774          |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 27 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) 1-35,37,43 and 44 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 36, 38-42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

The rejections of a prior Office Action dated November 20, 2002 are maintained.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specification does not disclose exactly what a "softer" component is. Nothing in the disclosure would lead one skilled in the art to understand what this is. In regards to a "hard" component, Applicant has disclosed a hard *particle* such as silicon. The Examiner takes the position that the hard component is equivalent to silicon.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,745,032 to Morrison.

Morrison teaches an article of construction suitable for a variety of substrates such as tile, brick, and galvanized surfaces comprising a coating of 35-70 weight % silicon dioxide and 20-40 weight % of aluminum oxide. See col. 8, lines 7-15 and col. 6, lines 55-65. At col. 14, line 20,

Morrison explains the use of the construction material may be applied to traffic ways, which is inclusive of flooring materials. The Examiner notes the phrase “wherein the modification results from removing a substantial amount of softer components...”, are process limitations in a product claim and hence are not afforded any patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

1. Claims 36 and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,314,554 to Owens.

Owens teaches a method of producing a laminated tile, where quarry tile is suitable for use and the tile composition is of 60-75% by weight silica and 15-25 % by weight alumina at col. 7, lines 1-40. The coefficient of friction is an inherent property of the tile itself. Because the tile of Owens is made of the components as Applicant claims, the claimed features would therefore be inherent. Further, the tile is not a different product because it is wet or dry, clean or soiled. The Examiner notes the phrase “wherein the modification results from removing a substantial amount of softer components...”, are process limitations in a product claim and hence are not afforded any patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re*

*Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 36 and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,787,655 to Saylor, Jr. in view of USPN 4,745,032 to Morrison and USPN 4,698,249 to Brown.

Saylor teaches a slip-resistant cover of a polymer film with particles or beads contained within the film. The beads may be of any material that can be embedded into a polymer film and have a friction coefficient to provide slip-resistance to a surface. See col. 1, lines 15-30. Saylor teaches his desired beads of choice are stone and have a coefficient of friction above 0.5 when wet or dry, meeting Applicant's ranges of 0.5 to 1.0 of claims 39-42. See col. 4, lines 1-15. Saylor is silent to a friction coefficient value below 0.5, but as Saylor mentions, depending upon the desired bead chosen, the friction coefficient will be provided. Hence, it would have been obvious to one of ordinary skill in the art to modify the cover of Saylor to include a component exhibiting a friction coefficient from 0.3 to 0.5 when soiled or wet since Saylor teaches such a value is dependent upon the choice of material and choice of material provides sufficient toughness and hardness to resist wear. See col. 3, lines 31-59 and col. 4, lines 1-30. The

Examiner notes the phrase "wherein the modification results from removing a substantial amount of softer components...", are process limitations in a product claim and hence are not afforded any patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

At col. 4, lines 20-32, Saylor lists suitable beads are of aluminium silicate, silicon carbide, aluminum oxide, or mixtures of the aforementioned compounds containing aluminium and silicon. While Saylor does not specify the weight percentages of claim 36, Saylor teaches the coefficient of friction value is dependent upon what material the bead is comprised of. Morrison teaches an article of construction comprising a coating of 35-70 weight % silicon dioxide and 20-40 weight % of aluminum oxide suitable for a variety of substrates such as tile, brick, and galvanized surfaces. See col. 8, lines 7-15 and col. 6, lines 55-65. Hence it would have been obvious to one of ordinary skill in the art to modify the components of Saylor to further specify weight percentages of the components since Morrison teaches using weight percentages of the components for tile at col. 6, lines 55-65 and col. 8, lines 7-15.

Saylor is silent to specifically teaching quarry tile of claim 38. Brown teaches modular accessible units, which is a flooring material of tile and teaches tiles may be ceramic tile like quarry. See col. 3, lines 8-25 and col. 8, lines 50-65. Therefore it would have been obvious to one of ordinary skill in the art to modify the coating of Saylor to include quarry tile since Brown

teaches tiles may be of any shape or material including ceramic, stone, and granite as listed in col. 8, lines 45-68.

*Response to Arguments*

4. Applicant asserts that a tile floor is modified, and hence a new structure and therefore does not believe Morrison discloses the claimed invention. The Examiner does not agree. Process limitations are given little patentable weight. Morison includes the same materials as Applicant claims, and hence teaches the invention. Applicant submits Morrison does not disclose a floor surface with modified structure where the modification results in removing a substantial amount of softer components of the tile while leaving a substantial amount of hard components. Applicant also asserts the tile is no longer a new tile but has a modified structure. Applicant has merely introduced process limitations. The floor tile continues to contain the same components as the floor tile in the reference. Therefore, the floor tile of the reference is considered to be the same, whether wet, dry, clean or dirty. The Examiner does not agree that the modification would make a different structure, especially since no definition is given to the "softer components". The process limitations therefore add no patentable weight to the product claims as written.

5. Applicant further asserts that Owens does not teach the claimed invention. The Examiner disagrees because the same ranges of percentages and same materials are taught by Owens as in the instant application. Since the same materials are present in the same ranges, then the invention is the same along with the coefficient of friction. Modifications are process limitations and are given little patentable weight.

6. Applicant urges Saylor, Morrison, and Brown do not disclose the instant invention.

Again, the Examiner disagrees. Saylor, Morrison, and Brown all teach flooring materials and have the same claimed materials and ranges as Applicant. Applicant's "modified structure" does not appear to be modified at all. Saylor, Morrison, and Brown collectively teach how to make flooring from the same materials as Applicant uses. Applicant's process limitations add little weight to the product claim.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus  
Examiner  
Art Unit 1774

May 29, 2003

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

